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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/431,451 | 11/01/1999 | PERIANNAN SENAPATHY | 34623.005 | 8738 |

7590 01/08/2004

INTELLECTUAL PROPERTY DEPARTMENT
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MADISON, WI 537171914

EXAMINER

SISSON, BRADLEY L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1634

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

Advisory Action

Application No.

09/431,451

Applicant(s)

SENAPATHY, PERIANNAN

Examiner

Bradley L. Sisson

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

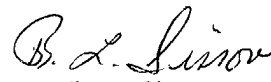
Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-8, 10-12, 14-26, 28 and 29.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


Bradley L. Sisson
Primary Examiner
Art Unit: 1634

Continuation of 5. does NOT place the application in condition for allowance because: The response does not demonstrate that the claimed invention does not encompass the embodiments taught by the prior art of record.

At page 2 of the Rule 1.116 response received 24 November 2003, hereinafter the response, applicant asserts that a point of distinction exists in the size of the nucleic acid to be sequenced. Namely, that the prior art is directed to "completely sequencing very large fragments of DNA" while the claimed invention is asserted to "not" involve complete sequencing, but rather "the aim and object of the present invention is specific sequencing of only those areas of interest." It is noted with particularity that there is nothing that prohibits the "those areas of interest" from being the "very large fragments." Accordingly, applicant is arguing limitations not present in the claims.

At page 2 of the response applicant asserts that another point of distinction resides in the "unique sequence." As stated therein: "The 'unique sequences' of Kamb are not designed (as is the fixed portion of Applicant's primers) to amplify a pre-selected area of the target nucleic acid. As noted earlier, Kamb's primers bind randomly to the target. The 'unique sequence' of Kamb is included solely to provide a known hybridization primer site for subsequent sequencing."

The above argument has been fully considered and has not been found persuasive towards the withdrawal of the rejection. As stated in Claim 1 (four times amended), a "subset" of "first primers" binds not to a "pre-selected area," but rather binds to a "consensus sequence of interest substantially wherever it occurs." Also used is a "second primer" that "binds to the template at locations removed from the first primers." The aspect of being "removed" has been interpreted as being able to bind randomly anywhere else on the template so long that there is at least 1 unpaired template nucleotide between the first and second primers. While Kamb may be able to use their 'unique sequence' in a sequencing method as well, such does not proscribe that same 'unique sequence' from also being capable from binding to a region of interest. The fact that prior art may arrive at the same material steps for different reasons or additional reasons does not make the same steps now patentable.

Accordingly, and in the absence of convincing evidence to the contrary, the rejection is maintained.